

Serial No. 10/730,512

Atty. Docket 29617/37215B

IN THE UNITED STATES PATENT
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Serial No. : 10/730,512

Confirmation : 2347

Date of Deposit:

September 21, 2005

SEP 21 2005

Applicants : Witz et al.

Filed : December 8, 2003

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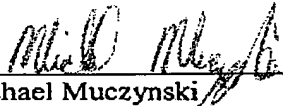
Art Unit : 3751

Examiner : LE, Huyen D.

facsimile number (571) 273-8300.

Atty Docket : 29617/37215B

Customer No. : 04743


Michael MuczynskiPRE-APPEAL BRIEF REQUEST FOR REVIEWCommissioner for Patents
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Sir:

The applicants hereby request a pre-appeal brief conference for a panel of examiners to formally review the legal and factual basis of the rejections in the application, prior to the filing of an appeal brief.

No amendments are being filed with this request. This request is being submitted concurrently with the Notice of Appeal.

It is submitted that the rejections are legally and factually inadequate, for the reasons concisely described on the following pages.

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Claims 1-3, 7, 8, and 28 were rejected under 35 U.S.C. § 103(a) in view of Kauffman U.S. Patent No. 6,183,155.

The obviousness rejection is legally and factually inadequate because a proper obviousness analysis was not performed with respect to the recited instrument, in particular: (1) the passage mean thickness; (2) a porous tip disposed within a feed tube; and (3) the instrument wherein the portion of the tip disposed within the feed tube extends a portion of the length of the feed tube.

Passage Dimension

The Kaufmann '155 patent does not render the claims obvious because it does not disclose or suggest an instrument as claimed having the recited passage with "a mean thickness of about 0.010 in. to about 0.025 in" (see claim 1).

The May 31, 2005, official action acknowledges that the Kaufmann '155 patent does not disclose all elements of claim 1, including the recited passage (see page 4, first paragraph). The obviousness rejection is premised on the proposition that "using the optimum or workable ranges involves only routine skill in the art," citing to *In re Aller*, 105 USPQ 233 (CCPA 1955).

It is respectfully submitted that the cited case does not stand for the broad proposition advanced. *In re Aller* merely supports the well-established principle that it is *prima facie* obvious to optimize a result-effective variable within prior art conditions. MPEP § 2144.05. A recognition in the art that the variables are result-effective is also necessary to support such a *prima facie* case of obviousness. *Id.*, citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) "(The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.)"

In the present case, the principle supported by *In re Aller* is unavailing because (1) there is no showing of a recognition in the art that the passage thickness is a result-effective variable; (2) there is no showing that the claimed range is within prior art conditions, and (3) the claimed range is outside the prior art conditions taught by the Kaufmann '155 patent, which actually teaches away from the claimed invention.

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The response after final filed August 1, 2005, pointed out that the Kaufmann '155 patent does specifically disclose the dimension of the passage 24. See column 3, line 65, to column 4, line 4:

As is immediately apparent from FIGS. 1 and 4, the passages 20 in FIG. 1 and 24 and 26 in FIG. 4 are of considerable axial length which in normal writing implements is in the range that is at least greater than 0.5 cm whereby it is possible to circumvent the flow resistant [sic] of the wick 10 or the total flow resistance for the liquid to be applied can be considerably reduced.

The dimension specified in Kaufmann '155 of "greater than 0.5 cm" (0.2 inches) is well outside the claimed range of about 0.010 in. to about 0.025 in. The advisory action dated August 24, 2005, does not cure the deficiency in the *prima facie* case, but instead presents the wholly conclusory statement: "it would have been obvious to one of ordinary skill in the art."

The reason for the difference in dimension is apparent from the difference in function of the instruments. See the argument in the applicants August 1, 2005, response at page 5, last paragraph, to page 6, third paragraph.

Porous Tip Disposed Within Feed Tube

Claim 1 recites an instrument including a "porous tip disposed within a feed tube." The rejection mischaracterizes the Kaufmann '155 patent as describing such an instrument, having a porous tip disposed within a feed tube. The May 31, 2005, official action refers to element 18 of the Kaufmann '155 patent as a feed tube (see page 2 of the official action, three and five lines from the bottom). Instead, element 18 is an opening in the divider wall 4. See column 1, lines 19-20, of Kaufmann '155.

The Kaufmann '155 patent does not disclose a feed tube. The official action implicitly admits as much, by referring to the separate, independent U-shaped portions shown in Fig A-A' of Fig. 4. The recited element simply is not found in the Kaufmann '155 patent.

Furthermore, no attempt is made to present a *prima facie* case of obviousness with respect to this element, for example by modification of the Kaufmann '155 patent or combination with another piece of prior art. The official action is facially defective.

Furthermore, similar to how there is no feed tube in Kaufmann '155, there also is no porous tip "disposed within" a feed tube (see claim 1).

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As previously described by reference to pages 5-6 of the August 1, 2005, response, the function of the instrument of the Kaufmann '155 patent and the claimed instrument are different. The lack of motivation to modify the Kaufmann reference is further supported by applicant's argument at page 7, last paragraph.

**The Portion of the Tip Disposed Within Feed Tube
Extends a Portion of the Length of the Feed Tube**

Claim 1 recites that the portion of the tip disposed within the feed tube extends a portion of the length of the feed tube. Thus, even if the wick 10 of Kaufmann '155 is considered as disposed within a feed tube, it is distinguished because it extends the entire length of the tube (the argument in this section is not to be interpreted as conceding that Kaufmann '155 discloses or suggests a feed tube according to the claims).

As the response in the official action (see page 4, second paragraph) is presently understood, it is based on the assertion that the wick 10 of Kaufmann can "include" portions that are disposed in the feed tube and that "one of the portions of the wick" extends a portion of the length of the feed tube. The rejection implicitly acknowledges that Kaufmann '155 does not disclose the claimed element, but the rejection neglects to make out a *prima facie* case of obviousness, including a motivation to modify the prior art with an expectation of success.

Furthermore, the rejection is based on a clear and obvious misreading of the claim. The claim recites that "the" portion of the tip disposed within the feed tube extends a portion of the length of the feed tube. The wick 10 of Kaufmann '155, Fig. 4, includes a portion that is not disposed within the feed tube (e.g., tip 12 and the lower portion held by front portion 8), and a portion that is, *arguendo*, disposed within a feed tube from opening 18 to front portion 8. Thus, "the portion" of the wick 10 which is disposed within the feed tube extends the entire length of the feed tube, and is thus distinguished from the claim.

The official action apparently wishes to divide the wick 10 into hypothetical portions that are disposed within the feed tube, and then find that the claim reads on one such portion. This approach effectively re-writes the claim. The claim, as drafted, recites that "the portion" of the tip which is disposed within the feed tube extends a portion of the length of the feed tube. The obviousness analysis does not pass muster.

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CONCLUSION


In view of the foregoing, it is submitted that there is no actual issue for appeal.
The application can be allowed on the existing claims, and prosecution can remain closed.

Respectfully submitted,

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September 21, 2005

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